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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,761	09/01/2000	Stephen P. A. Fodor	2719.2004-000	6146

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EXAMINER

PONNALURI, PADMASHRI

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/05/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,761

Applicant(s)

FODOR ET AL.

Examiner

Padmashri Ponnaluri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 172-212 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 172-212 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6, 9, 18. 6) ☐ Other:

DETAILED ACTION

- a. This application is a continuation of 09/557,875; which is a continuation of application 09/056,927; which is a continuation of 08/670,118; which is a divisional of 08/168,904; which is a continuation of 07/624,114; and 09/557,875 is a CIP of 07/492,462 and 08/348,471; which is a continuation of 07/805,727; which is a CIP of 07/492,462 and which is a CIP of 07/362,901.
- b. Applicants are requested to update the current status of the parent or elated applications in the specification.
- c. The preliminary amendments A, B filed on 9/1/00; and amendment C filed on 7/9/01; and amendment D filed on 2/26/02; and amendment E filed on 8/2/02; amendment F filed on 8/15/02 and amendment G filed on 7/3/03 have been fully considered and entered into the application.
- d. Claims 1-171 have been canceled and new claims 172-212 have been added by the preliminary amendment B filed on 9/1/00. Claims 172-177, 180-189, 192, 202-206, 208 and 212 have been amended by the amendment D filed on 2/26/02.
- e. Claims 172-212 currently are pending and are being examined in this application.
- f. The petition under 37 CFR 1.182 filed May 24, 2001 to change the order of the names of the inventors has been granted.

Drawings

The formal drawings filed on 10/9/01 have been accepted.

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The corrected or substitute drawings (figures 22A and B) were received on 6/4/03.

These drawings are acceptable.

Specification

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The abstract of the disclosure is objected to because the abstract is not applicable to the currently claimed invention. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 172-212 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 172 recites the limitation "said groups of polypeptides" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 180 recites the limitation "said groups of polypeptides" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 189 recites ' a process of making an array with at least two different polypeptides'. However, claim 189 is dependent on claim 185 which recites an array of more than 1,000 different groups of polypeptide molecules. It is not clear using the process of claim 189, an array of 1,000 different groups of polypeptides are formed.

Claim 210 recites the limitation "'said solid support'" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

g. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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h. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 172-212 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,384,261.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims are drawn to a method of forming a plurality of peptide sequences on a surface of a single substrate, which would result in an array of polypeptides of the instant claims.

8. Claims 172-212 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 5,677,195.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims are drawn to a method of forming oligonucleotide or peptides having a diverse sequence on a single substrate and the formed peptides on a surface according to the reference method would read on the instantly claimed substrate or an polypeptide array..

9. Claims 172-212 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,416,952.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims are drawn to a method of using an array of polypeptides on a substrate of the instant claims.

10. Claims 172-212 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,506,558 B1.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference ordered method for forming a plurality of different polypeptides would result in an array of different polypeptides of the instant claims.

11. NOTE since there are so many other pending applications of the same assignee in the USPTO, which is difficult for the examiner to find out any other application claims overlap with the instant application claims, applicants are requested to file terminal disclaimers on other related applications.

Allowable Subject Matter

12. The following is a statement of reasons for the indication of allowable subject matter: the instantly claimed 'array of polypeptides and substrate with plurality of polypeptides at a density of at least 400 different polypeptides' is neither taught nor suggested by the prior art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on Flex Schedule and can normally be reached on Monday through Friday between 7 AM and 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Padmashri Ponnaluri
Primary Examiner
Art Unit 1639

pp
August 1, 2003


PADMASHRI PONNALURI
PRIMARY EXAMINER